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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,002	10/16/2000	Scott C. Harris	SPAM/SCH	2977
23844	7590	12/01/2003	EXAMINER PHAN, TAM T	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			ART UNIT 2142	
DATE MAILED: 12/01/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/690,002

Applicant(s)

HARRIS, SCOTT C.

Examiner

Tam (Jenny) Phan

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following invention is required under 35 U.S.C. 121:
  - I. Claims 1-16 and 21-22 are drawn to e-mail filtering and classified in class 709, subclass 206.
  - II. Claims 17-20 are drawn to user monitoring and classified in class 709, subclass 224.
2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility, usable alone, such as the ability to filter unwanted e-mail message. Invention II has separate utility, usable alone, such as the ability to monitor user's action. See MPEP § 806.05(d)
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Harris Scott (32030) on 11/12/2003, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16 and 21-22. Affirmation of this election must be made by applicant in

replying to this Office action. Claims 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Examiner is appreciative of the courtesy shown by Applicant in discussions of this restriction requirement.

***Priority***

6. This application claims benefit of the provisional application 60/203,729 (05/12/2000).

7. The effective filing date for the subject matter defined in the pending claims, which has support in parent 60/203,729 in this application is 05/12/2000. Any new subject matter defined in the claims not previously disclosed in parent 60/203,729, is entitled to the effective filing date of 10/16/2000.

***Information Disclosure Statement***

8. The information disclosure statement (IDS) filed 02/13/2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The Non Patent Literature reference cited on IDS (Paper #2, received 02/13/2001 is not present in the application, and thus, could not be considered.

9. All other references, which were listed, are indicated on the initialed and dated copy of Applicant's IDS form 1449.

***Drawings***

10. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claim 1, 14-16, and 21-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Paul (U.S. Patent Number 5,999,932).

13. Regarding claim 1, Paul disclosed a method comprising: receiving an electronic mail message (Abstract, Figures 4, 4A & 6, column 10 line 24); displaying information about the electronic mail message in a way that allows at least one of deleting the message without indicating whether it is spam or not [second display code "NEW"] (Abstract, column 10 lines 41-43), deleting the message while indicating that it is spam [third display code "JUNK"] (Abstract, column 10 lines 47-48), or deleting the message while indicating that it is not spam [first display code "OK"] (Abstract, column 10 lines 31-32).

14. Regarding claims 14-16, the e-mail program corresponds directly to the limitations of claim 1, and thus is rejected using the same rationale.

15. Regarding claim 21, Paul disclosed a method, comprising determining a plurality of characteristics of an unwanted message (Figure 5, column 3 lines 54-65, column 56-67); forming a list with said plurality of characteristics (column 4 lines 34-40); forming score [first, second, and third display codes] of an incoming message by comparing said incoming message with said list and determining commonalities between said incoming message and said list (Abstract, Figure 6, column 2 lines 20-48); defining said message as likely being unwanted if said score is within a predetermined range (Abstract, column 9 lines 8-19); and taking an action to restrict said message based on said defining (Abstract, Figure 4A & 6, column 9 lines 1-7).

16. Regarding claim 22, Paul disclosed a method further comprising assessing a common-ness of a domain a sender of a message, and using said common-ness of said domain (column 11 lines 21-23, column 12 lines 54-61).

17. Since all the limitations of the claimed invention were disclosed by Paul, claims 1, 14-16, and 21-22 are rejected.

18. Claims 8-13 are rejected under 35 U.S.C. 102(e) as being anticipated by McCormick et al. (U.S. Patent Number 6,421,709), hereinafter referred to as McCormick.

19. Regarding claim 8, McCormick disclosed a method of determining whether an e-mail represents unwanted information, comprising forming rules indicative of contents of the e-mail (column 4 lines 60-65, column 5 lines 16-21), said rules including at least information about a sender of the e-mail message and information

about at least one other fields within the e-mail message other than said sender or a recipient of the e-mail message (column 6 lines 41-50, column 8 lines 58-65).

20. Regarding claim 9, McCormick disclosed a method wherein said at least one other field comprises information in text of the e-mail message (column 8 lines 58-65).

21. Regarding claim 10, McCormick disclosed a method wherein said at least one other field comprises information within a subject of the e-mail message (column 6 lines 41-50).

22. Regarding claim 11, McCormick disclosed a method wherein said at least one other field comprises information about links of said e-mail message [advertisement links] (column 6 lines 41-46, column 8 lines 58-65).

23. Regarding claim 12, McCormick disclosed a method further comprising comparing an incoming message to said rules and determining a likelihood that the incoming message is unwanted based on said comparing (column 4 lines 60-65, column 6 lines 41-50, column 14 lines 1-9).

24. Regarding claim 13, McCormick disclosed a method wherein said comparing comprises comparing each of the plurality of fields with rules indicative of said fields and determining a likelihood that the message is unwanted based on said comparing (column 4 lines 60-65, column 6 lines 41-50, column 14 lines 1-9).

25. Since all the limitations of the claimed invention were disclosed by McCormick claims 8-13 are rejected.

26. Claims 14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen (U.S. Patent Number 6,453,327).

27. Regarding claim 14, Nielsen disclosed an email program, comprising a display portion which is display a plurality of e-mails (Figure 4a, column 8 lines 14-43); a plurality of controls including at least a first control which selects deleting an e-mail while indicating that said e-mail is spam, and a second control which selects deleting an e-mail while indicating that said e-mail is not spam (Figure 4b, column 8 lines 14-43).

28. Regarding claim 16, Nielsen disclosed a program further comprising displaying a control which allows deleting an e-mail without indicating or not indicating whether said e-mail represent spam (Figure 4b, column 8 lines 14-43).

29. Since all the limitations of the claimed invention were disclosed by Nielsen claims 14 and 16 are rejected.

***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (U.S. Patent Number 5,999,932) as applied above in view of McCormick et al. (U.S. Patent Number 6,421,709), hereinafter referred to as McCormick.

32. Paul disclosed a method comprising: receiving an electronic mail message (Abstract, Figures 4, 4A & 6, column 10 line 24); displaying information about the electronic mail message in a way that allows at least one of deleting the message without indicating whether it is spam or not [second display code "NEW"] (Abstract, column 10 lines 41-43), deleting the message while indicating that it is spam [third display code "JUNK"] (Abstract, column 10 lines 47-48), or deleting the message while indicating that it is not spam [first display code "OK"] (Abstract, column 10 lines 31-32).

33. Regarding claim 2, Paul did not expressly disclose a method further comprising storing a database of spam likelihood, and wherein said deleting while indicating updates information in the database. Paul suggested exploration of art and/or provided a reason to modify storing "not spam likelihood" database with storing "spam likelihood" database (Figure 6 sign 650, column 9 lines 56-67, column 10 lines 1-11). McCormick disclosed a method further comprising storing a database of spam likelihood, and wherein said deleting while indicating updates information in the database (Figure 10, column 2 lines 62-67, column 5 lines 16-28).

34. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Paul with the teachings of McCormick to include storing a database of spam likelihood in order to offer a more efficient filtering technique since an incoming e-mail whole addresses are included in the spam database would be immediately discarded [processed] (McCormick, column 2 lines 55-57).

35. Regarding claim 3, McCormick disclosed a method wherein said deleting while indicating update rules in a rules database (column 2 lines 62-67, column 5 lines 16-21, column 8 lines 48-52).

36. Regarding claim 4, McCormick disclosed a method wherein said rules include information about fields from said electronic mail message (column 4 lines 60-65).

37. Regarding claim 5, McCormick disclosed a method wherein said fields include at least a sender of the e-mail message, text, of the e-mail message, and a subject of the e-mail message (Figure 2, column 4 lines 60-65).

38. Regarding claim 6, Paul disclosed a method wherein said fields also include a domain of a sender of the e-mail message (column 9 lines 38-45, lines 56-67, column 11 lines 21-23).

39. Regarding claim 7, McCormick disclosed a method wherein said fields include links within the e-mail message [advertisement links] (column 6 lines 41-46, column 8 lines 58-65).

40. Regarding claim 8, McCormick disclosed a method of determining whether an e-mail represents unwanted information, comprising forming rules indicative of contents of the e-mail (column 4 lines 60-65, column 5 lines 16-21), said rules including at least information about a sender of the e-mail message and information about at least one other fields within the e-mail message other than said sender or a recipient of the e-mail message (column 6 lines 41-50, column 8 lines 58-65).

41. Regarding claim 9, McCormick disclosed a method wherein said at least one other field comprises information in text of the e-mail message (column 8 lines 58-65).

42. Regarding claim 10, McCormick disclosed a method wherein said at least one other field comprises information within a subject of the e-mail message (column 6 lines 41-50).

43. Regarding claim 11, McCormick disclosed a method wherein said at least one other field comprises information about links of said e-mail message [advertisement links] (column 6 lines 41-46, column 8 lines 58-65).

44. Regarding claim 12, McCormick disclosed a method further comprising comparing an incoming message to said rules and determining a likelihood that the incoming message is unwanted based on said comparing (column 4 lines 60-65, column 6 lines 41-50, column 14 lines 1-9).

45. Regarding claim 13, McCormick disclosed a method wherein said comparing comprises comparing each of the plurality of fields with rules indicative of said fields and determining a likelihood that the message is unwanted based on said comparing (column 4 lines 60-65, column 6 lines 41-50, column 14 lines 1-9).

46. Since all the limitations of the claimed invention were disclosed by the combination of Paul and McCormick, claims 2-13 are rejected.

47. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (U.S. Patent Number 6,453,327) as applied above in view of Leeds (U.S. Patent Number 6,393,465).

48. Nielsen disclosed an email program, comprising a display portion which is display a plurality of e-mails (Figure 4a, column 8 lines 14-43); a plurality of controls including at least a first control which selects deleting an e-mail while indicating that said e-mail is spam, and a second control which selects deleting an e-mail while indicating that said e-mail is not spam (Figure 4b, column 8 lines 14-43).

49. Regarding claim 15, Nielsen did not disclose a program further comprising displaying a likelihood of spam coefficient which indicates, on a weighted scale, a likelihood that the associated message represents spam. However, Leeds disclosed a program further comprising displaying a likelihood of spam coefficient which indicates, on a weighted scale, a likelihood that the associated message represents spam [confidence rating scale from 0-100%, with 100% being the rating given to a message considered to be junk e-mail or spam] (column 2 lines 26-37, column 6 lines 49-66).

50. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the e-mail program of Nielsen with the teachings of Leeds to display the likelihood of spam coefficient in order to help users quickly filter their messages since the user would be able to have the message automatically discarded or have the message marked as potentially junk (Leeds, column 7 lines 18-27).

51. Since all the limitations of the claimed invention were disclosed by the combination of Nielsen and Leeds, claim 15 is rejected.

***Conclusion***

52. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MARC D. THOMPSON  
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tp  
November 24, 2003